UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,772	12/12/2001	Roger S. Kerr	83030NAB	8661

7590 04/16/2004

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER	
ROSSI, JESSICA	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,772	KERR ET AL.	
	Examiner	Art Unit	
	Jessica L. Rossi	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *2/5/04, Amendment*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) *2,3 and 8-52* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 2/5/04. Claims 1-52 are pending. Claims 2-3 and 8-52 were non-elected without traverse in paper no. 8 dated 11/4/03.

2. The rejection of claims 1 and 4-7 under 35 U.S.C. 112, 2nd paragraph, as set forth in paragraph 7 of the previous office action, has been withdrawn in light of the present amendment.

Drawings

3. The corrected drawings were received on 2/5/04. These drawings are acceptable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 4-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 1, the present specification does not teach and/or suggest "rapidly" embossing the surface of the pre-press proof. Applicant is asked to clarify. It is suggested to delete this term from the present claim.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is unclear what Applicant means by "rapidly" embossing. Since the specification fails to teach and/or suggest this limitation one skilled in the art cannot ascertain what Applicant considers "rapidly" to mean and therefore cannot determine the metes and bounds of the claim. Applicant is asked to clarify. It is suggested to delete this term from the claim.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeCook et al. (US 5203942; of record) in view of the collective teachings of Hicks (US 5359387; of record) and Lopez et al. (US 2003/0020945; of record), Akada et al. (US 5451560; of record), and Rohleder et al. (US 5429696; of record).

With respect to claim 1, it is known in the art to create a pre-press proof (column 3, line 10) using a thermal transfer lamination process, as evidenced by DeCook. The process involves forming an image 38 on the surface of backing layer 39 thereby forming an image transfer layer 34, bringing the image side of the transfer layer into contact with the surface of image reception layer 1a, and applying heat and pressure to laminate the transfer layer to the reception layer such that transfer of the image 38 to the surface of the reception layer takes place, and removing the backing layer from the laminate to form a pre-press proof, as taught by DeCook (column 8, lines

22-35). However, DeCook is silent as to embossing the surface of the pre-press proof while laminating to form a thermal mark thereon using an embossing belt having an embossing mark thereon.

It is known in the proof art to form markings (i.e. numbers, letters, symbols) on the surface of a proof thereby allowing for easy identification of the proofs and/or simplified ordering procedures for the same, as taught by the collective teachings of Hicks (Figure 2; column 2, lines 5-8; column 3, lines 16-17 and 21-40; column 4, lines 42-47) and Lopez (Figure 1a; [0013]; [0037]; [0038]).

Therefore, it would have been obvious to the skilled artisan at the time the invention was made to form markings on the surface of the proof of DeCook because such is known in the art, as taught by the collective teachings of Hicks and Lopez, and this allows for easy identification of the proofs and/or simplified ordering procedures for the same.

It is known in the thermal transfer lamination art to form an image on the surface of a backing layer thereby forming an image transfer layer, bring the image side of the transfer layer into contact with the surface of an image reception layer, and apply heat and pressure to laminate the transfer layer to the reception layer such that transfer of the image to the surface of the reception layer takes place, and removing the backing layer from the laminate to form an imaged substrate, as taught by Akada et al. (abstract; column 1, lines 11-13; column 2, lines 41-42; column 3, lines 16-18; column 16, lines 10-11; column 17, lines 11-12; column 27, lines 45-61; column 28, line 58 – column 29, line 31). Akada also teaches this thermal transfer lamination process being combinable with an embossing step to form markings such as characters and numbers on the surface of the imaged substrate (column 33, lines 55-62).

It would have been obvious to the skilled artisan at the time the invention was made to form the markings of DeCook in view of the collective teachings of Hicks and Lopez by embossing because such is known in the image transfer art, as taught by Akada, thereby eliminating the need for writing on the proofs which can lead to permanent damage thereof.

As for a particular embossing mechanism, it would have been obvious to the skilled artisan at the time the invention was made to use an embossing belt having the desired marking thereon to emboss the pre-press proof (comprising laminated layers) of DeCook while laminating to form a thermal mark thereon because it is known in the embossing/laminating art to emboss the surface of a composite 21 (comprising laminated films 14-16) while laminating the composite between an embossing belt 34 having an embossing mark thereon and a heated roller 1 to form a thermal mark on the composite, as taught by Rohleder (Figure 5; column 5, lines 35-42; column 7, lines 32-33 and 48-67), wherein this allows for embossing in a continuous manner thereby expediting the overall manufacturing process.

Please note similarities between the embossing/laminating of Rohleder as shown in Figure 5 and that of the present invention as disclosed on p. 4, lines 21-30 – both teach laminating layers to create a composite (i.e. pre-press proof in case of present invention) that is further laminated by an embossing belt.

10. Claims 4-5 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over DeCook et al., the collective teachings of Hicks and Lopez et al., Akada et al., and Rohleder et al. as applied to claim 1 above, and further in view of Metzger (US 6177234; of record).

Regarding claim 4, DeCook is silent as to the type of image formed on the pre-press proof. Selection of a particular type would have been within purview of the skilled artisan

depending on the desired qualities of the proof. However, it would have been obvious to form a monochrome image because such is known in the art, as taught by Metzger (abstract; column 2, line 10; column 6, lines 57-58).

Regarding claim 5, Metzger also teaches forming a multi-colored image (abstract; column 2, line 10; column 6, lines 57-58).

Regarding claim 7, DeCook is silent as to the pre-press proof being a dual sided one. It would have been obvious to form a dual sides pre-press proof for the proof of DeCook because such is known in the art, as taught by Metzger (column 2, lines 51-53; column 3, lines 56-57; column 5, lines 21-22), and this allows for cost reduction since the number of image reception layers can be reduced by half.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeCook et al., the collective teachings of Hicks and Lopez et al., Akada et al., and Rohleder et al. as applied to claim 1 above, and further in view of Hoisington et al. (EP 0949081; of record).

Regarding claim 6, DeCook is silent as to how the image is formed. One reading the reference as a whole would have appreciated that such is not critical to the invention and therefore selection of a particular method would have been within purview of the skilled artisan. However, it would have been obvious to form an inkjet-generated image because such is known in the art, as taught by Hoisington (column 1, lines 12-13 and 19-21).

Response to Arguments

12. Applicant's arguments filed 2/5/04 have been fully considered but they are not persuasive.

13. On page 13 of the arguments, Applicant argues that the 112 2nd paragraph rejections set for in the previous office action should be removed because Applicant amended the claim by incorporating "consisting of" language while also inserting a dpi resolution range of between 1000-4000 dpi.

While the examiner removed the 112 2nd paragraph rejections in light of the present amendment to claim 1, the examiner would like to point out that this amendment did not incorporate any "consisting of" language or dpi resolution ranges. Therefore, any argument pertaining to such limitations is not commensurate with the scope of the claimed invention.

14. On page 14 of the arguments, Applicant argues that the DeCook '942 reference is commonly owned by the assignee of the present invention and therefore the 103(a) rejections set forth in the previous office action using this reference can be removed by the terminal disclaimer dated 2/5/04.

The examiner does not dispute that the DeCook reference and the present invention are commonly owned. However, DeCook qualifies as prior art under 102(b) because its publication date is 4/20/93 whereas the effective filing date of the present invention is 12/12/01. Therefore, since DeCook's 102(e) date is not being relied upon, the 103(a) rejections set forth in the previous and/or current office action cannot be overcome by a terminal disclaimer (see 35 U.S.C. § 103(c)).

15. On page 14 of the arguments, Applicant argues that Hicks fails to teach laminating while also failing to teach thermal embossing for images with a dpi of 1000-4000.

The examiner would like to point out that Hicks was only used to show it is known in the proof art to form markings, such as numbers/letters/symbols, on the surface of the proof. As for

Hicks failing to teach thermal embossing for images with a dpi of 1000-4000, this argument is not commensurate with the scope of the claimed invention.

16. On page 14 of the arguments, Applicant argues that Lopez fails to teach embossing the proof sheet to form the markers.

The examiner would like to point out that Lopez was only used to show it is known in the proof art to form markings, such as numbers/letters/symbols, on the surface of the proof.

17. On page 14 of the arguments, Applicant argues that the resulting laminate of Akada is not a pre-press proof.

The examiner points out that Akada was only used to show it is known in the image transfer art to combine a laminating step with an embossing step.

18. On pages 14-15 of the arguments, Applicant argues Metzger does not suggest embossing.

The examiner points out that Metzger was only used to show that monochrome images, multi-colored images, and dual sided pre-press proofs are known in the pre-press proof art.

19. On page 15-16 of the arguments, Applicant argues that Hoisington does not teach an embossing belt.

The examiner points out that Hoisington was only used to show inkjet-generated images are known in the pre-press proof art.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi
Patent Examiner
Art Unit 1733

JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300